

REMARKS

The applicant respectfully requests reconsideration in view of the amendments and the following remarks. Support for newly added claim 36 can be found in claim 20. Claim 36 is narrower than the previously submitted presented claim 20 prior to the last amendment of claim 20, because it limits that amino acid derivative to β amino acid derivatives. Support for newly added claims 37 through 39 can be found in the specification at page 4.

The applicant authorizes the USPTO to charge the applicant's American express card for the four extra total claims over twenty added.

Claims 1-18 and 20-35 are rejected under 35 U.S.C. 112, because the specification, while being enabling for preparing several amino acid derivatives, does not reasonably provide enablement for preparing all amino acid derivatives selected form listed in claim 1 such as 2-piperidineacetic acid. Claims 1-18 and 20-35 are rejected under 35 U.S.C. 112, as failing to comply with the written description requirement. The applicant respectfully traverses these rejections.

112 Rejections

Claims 1-18 and 20-35 are rejected under 35 U.S.C. 112, because the specification, while being enabling for preparing several amino acid derivatives, does not reasonably provide enablement for preparing all amino acid derivatives selected form listed in claim 1 such as 2-piperidineacetic acid.

The applicant first points out that claims 13, 34 and 35 do not require 2-piperidineacetic acid. These claims are directed to the product obtained is β -homovaline, β -homophenylalanine,

ϵ -trifluoroacetyl- β -homolysine, β -homolysine, β -homoaspartic acid, or β -homoproline. This rejection clearly does not apply to these claims.

The applicants believe that one of ordinary skill in the art would understand the invention and that there would be no undue experimentation required. Based on the contents of the disclosure each and every aspect of the claimed invention can be performed by routine experiments with the knowledge of the skilled worker (see pages 3-13 of the specification).

In addition, the applicants do not have to have examples for the claims to be enabled (see In re Strahilevitz, 212 USPQ 561, 563, 564 (CCPA 1982), In re Stephens, 188 USPQ 659, 661 (CCPA 1976), In re Honns and Sims, 150 USPQ 652 (CCPA 1966), In re Marzocchi and Horton, 169 USPQ 367 (CCPA 1971).

The court stated in re Stephens, supra at page 661,

The solicitor variously interprets 'specific embodiment' required by the rule as 'a complete example specifying all necessary details - including the essential materials, particle size where relevant and proportions, as well as the relevant specific parameters or conditions of the process and the essential physical characteristics of the product' and as a 'specific example' or what is commonly referred to as a working example. A working example, however, is not always necessary. In re Long, 54 CCPA 835, 368 F. 2d 892, 151 USPQ 640 (1966). ... The test is whether there is sufficient working procedure for one skilled in the art to practice the claimed invention without undue experimentation.

In addition to the presence or absence of a working example, relevant considerations are the nature of the invention, the state of the prior art, and the relative skill of those in that art. In re Honn, 53 CCPA 1449, 364 F.2d 454, 150 USPQ 652 (1966). (emphasis added)

The Court of Custom Appeals stated at page 369 in re Marzocchi and Horton, 169 USPQ 367, 369 (CCPA 1971),

The first paragraph of §112 requires nothing more than objective enablement. How such a teaching is set forth, either by the use of illustrative examples or by broad terminology, is of no importance. (emphasis added)

The Court of Custom Appeals stated at page 563 in re Strahilevitz, 212 USPQ 561, 563, 564 (CCPA 1982),

We recognize that working examples are **desirable** in complex technologies and that detailed examples can satisfy the statutory enablement requirement. Indeed, the inclusion of such examples here might well have avoided a lengthy and, no doubt, expensive appeal. Nevertheless, as acknowledged by the board, examples are not required to satisfy section 112, first paragraph rejection. (emphasis added)

In fact as discussed in the cases above, a patent application does not need to contain any examples for the application to be enabled. However, the applicants' application contains 3 synthesis examples for example 1 and 3 synthesis examples for example 2. The applicants believe that it is clear from their specification, that there is adequate support and enablement for the claims.

The Court of Custom Appeals further stated at page 369 in In re Marzocchi and Horton, 169 USPQ 367, 369 (CCPA 1971),

As a matter of Patent Office practice, then, a specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as in compliance with the enabling requirement of the first paragraph of §112 unless there is reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. (In re Marzocchi and Horton, 169 USPQ 367, 369 (CCPA 1971)). (emphasis added)

For the above reasons, this rejection should be withdrawn.

Claims 1-18 and 20-35 are rejected under 35 U.S.C. 112, as failing to comply with the written description requirement. In particular, the Examiner stated that the term "carbanionic reagent" in step (b) is not defined in the specification (see page 5 of the Office Action). This term is defined at page 3 lines 1-5 and page 4, lines 11-15 of the specification. The applicant believes that this term is clear to one of ordinary skill in the art.

Furthermore, claims 37-39 further limit the carbanionic agent. For the above reasons, this rejection should be withdrawn.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

A two month extension has been paid. Applicant believes no additional fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 05129-00103-US from which the undersigned is authorized to draw.

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Respectfully submitted,

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